

REMARKS

I. Amendments

By this amendment, claim 21 has been amended, new claims 24-32 have been added and claim 22 has been canceled.

This amendment adds no new matter to the specification. Support for this amendment is found in the specification and claims as filed.

No change of inventorship is necessitated by this amendment.

II. *Third Request for Consideration of a Previously Submitted Information Disclosure Statement*

This is yet another repeat of a request which has previously been made. Applicants urge the Examiner to address this outstanding issue in the prosecution of their patent application.

Applicants filed an Information Disclosure Statement, Form 1449 and four cited references on April 6, 2001, but they have not received initialed PTO-1449 forms indicating the Examiner's review of the disclosed documents. According to the Notification Of Acceptance of Application dated July 5, 2001, the filed Information Disclosure Statement and cited references were in fact received.

Applicants respectfully request the Examiner's consideration of the previously submitted references. If the 1449 or copies of any of the references are missing from the Examiner's file, replacements may be obtained from Applicants' Attorney.

III. Discussion of Advisory Action

The Advisory Action mailed July 24, 2003 indicates that the previously filed amendment would be entered, but that there were still no allowable claims, for various reasons. The outstanding issues will be addressed in the subsequent paragraphs.

IV. Discussion of the Objection to Claim 13

Claim 13 was listed as objected to in the Summary page of the Advisory Action. It had originally been listed as objected to in the Office Action dated April 9, 2003. Applicants respectfully request the Examiner's clarification of the status of claim 13, as they are uncertain as to why this claim would be only objected whereas all of the other claims which are dependent upon claim 1 are listed as rejected. In particular, Applicants wonder how the limitations of claim 13 cause the Examiner to categorize that claim as being in conformance with the restriction requirement, whereas the other claims are not so categorized.

V. Discussion of the Restriction Requirement

The Advisory Action indicated that the pending claims still need to conform to the restriction requirement to be allowable.

As Applicants have previously argued, they believe that their claims are already so limited. However, by this amendment, Applicants have added new independent compound claim 27, which resembles the requirements stated on page 2 of the Examiner's Action of April 9, 2003 as closely as possible, while adhering to the terminology used in the specification.

Applicants have noted that the Examiner has required two different definitions for the variable A. The Examiner's unclear and confusing comments lead Applicants to believe that their invention as set forth in the pending claims has neither been understood nor properly evaluated. Moreover, this inconsistency (as well as the confusion over claim 13 cited in Sec. IV above) has caused Applicants to question the appropriateness of the Examiner's insistence that conformance with the restriction requirement has not yet been attained.

In new independent claim 27, the variables which have been limited in a manner which varies slightly from the Examiner's suggested definitions are discussed below:

ring A is a homocyclic aromatic ring substituted with halogen, instead of “carbocyclic aryl” (which was suggested by the Examiner, though this phrase is not used in the specification);

ring B is a cyclic hydrocarbon group, instead of “carbocyclic group” (which was suggested by the Examiner, though this phrase is not used in the specification), furthermore there is no need to add “substituted with amino alkyl moiety” to the definition for ring B, as the formula in the claim shows the substituent LR²;

Z is a halogenated cyclic hydrocarbon group, instead of “halogenated carbocyclic group” (which was suggested by the Examiner, though this phrase is not used in the specification);

R¹ is an acyl group substituted with an optionally substituted hydrocarbon group, instead of “acyl group substituted with biphenyl” (which was suggested by the Examiner, though this phrase is not used in the specification); and

D is methylene, ethylene, propylene or butylene, instead of “C₁₋₄ alkylene” (which was suggested by the Examiner, though this phrase is not used in the specification).

Applicants contend that new claim 27 is in accordance with the restriction requirement. Should the Examiner wish to deny that claim 27 is in compliance, Applicants respectfully request that the Examiner indicate which variables in particular are non-compliant, and her suggested language for bringing them into compliance.

Furthermore, new claim 28 has been added which is the species originally elected. It logically must be in compliance with the restriction requirement.

Applicants continue to maintain that independent claims 1, 14, 18 and 21 are already in accordance with the restriction requirement. Claims 2-7, 9, 13, 15 and 17 depend from claim 1. In particular, claim 14 recites the variables A, B and Z even more narrowly than the Examiner’s categorizations of April 9, 2003. In addition, claim 15 is a dependent claim which limits many of the variables of claim 1 further. Moreover, as Applicants stated above, they do not understand how claim 13 can be in conformance with the restriction requirement when other

dependent claims are not. For this reason, the Examiners specific comments on claims 13-15 are requested.

For these reasons, Applicants respectfully submit that they have complied with the restriction requirement.

VI. Discussion of the Rejection of Claim 21 under 35 U.S.C. Sec. 112, First Paragraph

Claim 21 has been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking enablement.

By this amendment, the subject matter of claim 21 has been amended to recite only a method for treating diabetes. New independent claim 24 is directed to a method for treating obesity; new independent claim 25 is directed to a method for treating complications of diabetes and new independent claim 26 is directed to a method of treating intractable diarrhea.

Furthermore, the new independent method claims 29-32 have been added, which recite the treating compound more specifically.

If it is the Examiner's opinion that any of claims 21, 24-26 or 29-32 lack enablement, Applicants respectfully request that the Examiner let Applicants know what specific aspects of the claims she finds to be unacceptable, rather than merely stating "the claims as recited are broader than the scope of enablement" which is unhelpful in the Applicants' quest to determine exactly what scope of the claims the Examiner *would* consider to be enabled.

Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claim 21.

VII. Discussion of the Rejection of Claim 22 under 35 U.S.C. Sec. 112, First Paragraph

The Examiner has maintained the rejection of claim 22 under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking utility.

By this amendment, Applicants have cancelled claim 22.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claim 22.

VIII. Conclusion


Consideration of the claims as amended and allowance of claims 1-7, 9, 13-15, 17, 18, 21 and 24-32 is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

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